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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,319	01/26/2004	Vikram Madan	003797.00724	1220

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EXAMINER

LEWIS, ALICIA M

ART UNIT	PAPER NUMBER
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2164

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/766,319	Applicant(s) MADAN ET AL.	
	Examiner Alicia M. Lewis	Art Unit 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is responsive to communication filed December 19, 2006.

Claims 1-9 are canceled, claims 1-12 are amended, and claims 13-19 have been added. Therefore claims 10-19 are pending in this application.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 10, 11 and 19 are directed to a method for obtaining context information. This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful, concrete and tangible result.

Specifically, the claimed subject matter does not always produce a tangible result because the claimed subject matter fails to always produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides for storing the URI property as context information, **only in response to successfully retrieving an application interface having a URI property**. Therefore, when an application interface having a URI property is not successfully retrieved in step c, there is no tangible result, and in this

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case the produced result remains in the abstract and, thus, fails to achieve the required status of having real world value.

Claims 12-14 are directed to a method for determining text associated with a selected region. This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful, concrete and tangible result.

Specifically, the claimed subject matter does not always produce a tangible result because the claimed subject matter fails to always produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides for storing actual text including the text within the selected region, **only if the bounding box is determined to be within the selected region**. Therefore, when the bounding box is not within the selected region, there is no tangible result, and in this case the produced result remains in the abstract and, thus, fails to achieve the required status of having real world value.

Claims 15-18 are directed to a method for associating selected content and context information. This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful, concrete and tangible result.

Specifically, the claimed subject matter does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for

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example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides creating an association between the selected content and the context information. This produced result remains in the abstract and, thus, fails to achieve the required status of having real world value.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 12-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Harui (US Patent 6,690,394 B1).

With respect to claim 12, Harui teaches a method for determining text associated with a selected region comprising the steps of:

finding text in an element within the selected region (column 1 lines 50-52);

determining a bounding box of the text within the element (column 4 lines 4-7, column 5 lines 64-67);

determining if the bounding box of the text is within the selected region (column 3 line 66 – column 4 line 10, column 5 lines 33-64); and

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if the bounding box is determined to be within the selected region, storing as context information actual text including the text within the selected region (column 1 lines 61-63, column 8 lines 53-55).

The last limitation in claim 12 (step d) is optionally recited and does not limit the scope of the claim. (See MPEP 2111.04)

With respect to claim 13, Harui teaches wherein the actual text is within the selected region (column 1 lines 50-52, column 5 lines 64-67).

With respect to claim 14, Harui teaches wherein if the bounding box is determined not to be within the selected region, repeating steps b) to d) with different text in the element within the selected region (column 5 lines 33-67).

Because the selected region in Harui may be the entire web page, the bounding box will always be within the selected region. Claim 14 is also optionally recited.

With respect to claim 15, Harui teaches a method for associating selected content and context information, comprising:

receiving a selection of web page content or a selection of a region of a document displayed in an on-screen region of a display (column 3 line 66 – column 4 line 1);

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determining, based on the received selection, context information of the web page or the document, the context information being a uniform resource identifier (column 4 lines 20-26); and

creating an association between the selected content and the context information (column 4 lines 20-26).

With respect to claim 16, Harui teaches further including storing the association between the selected content and the context (column 8 lines 53-55).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10, 11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harui (US Patent 6,690,394 B1) in view of Oppermann et al. (US Patent 6,334,157 B1) ('Oppermann').

With respect to claim 10, Harui teaches a method for obtaining context information comprising the steps of:

receiving a selection of a region of web page content displayed in an on-screen region of display (column 3 line 66 – column 4 line 1);

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determining a window associated with the selected region (column 4 lines 4-7);
and

in response to successfully retrieving a user interface window, storing the URI property of the window as context information (column 8 lines 53-55).

Harui does not teach attempting to retrieve an application interface having a URI property from the window; or the storing of the URI property of the window as context information being in response to successfully retrieving an application interface having a URI property.

Oppermann teaches programmatically providing direct access to user interface elements of an application program (see abstract), in which he teaches:

attempting to retrieve an application interface having a URI property from the window (column 25 lines 59-62, column 28 lines 33-39); and

in response to successfully retrieving an application interface having a URI property, storing the URI property of the window as context information (column 11 lines 1-9, 55-60, column 12 lines 55-59).

The last limitation of claim 10 is optionally recited.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Harui by the teaching of Oppermann because attempting to retrieve an application interface having a URI property from the window; and in response to successfully retrieving an application interface having a URI property, storing the URI property of the window as context information would enable accessibility aids the ability to access and manipulate user interface elements of any

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application program without having prior knowledge of the application program or its interface (Oppermann, column 4 lines 27-30).

With respect to claim 11, Harui as modified teaches the method according to claim 10, further comprising the step of: in response to unsuccessfully retrieving an application interface having a URI property, repeats steps c) and d) for a parent window of the window (Oppermann, column 28 lines 40-62; Harui, column 5 lines 33-64).

With respect to claim 19, Harui as modified teaches wherein the window is a top level application window (Harui, column 5 lines 46-53; Oppermann, column 28 lines 45-54).

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harui (US Patent 6,690,394 B1) in view of Carro (US Patent Application Publication 2003/0117378 A1).

With respect to claim 17, Harui teaches further including storing the association between the selected content and the context (column 8 lines 53-55).

Harui does not teach wherein the association is a single file.

Carro teaches a device and system for retrieving and displaying handwritten annotations (see abstract), in which he teaches wherein the association is a single file (paragraphs 54 and 55).

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It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Harui by the teaching of Carro because wherein the association is a single file would enable a new apparatus and system adapted to associate additional information with physical documents while keeping intact the integrity of the physical documents (Carro, paragraph 4).

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harui (US Patent 6,690,394 B1) in view of Ross (US Patent 5,983,215) ('Ross').

With respect to claim 18, Harui teaches further including storing the association between the selected content and the context (column 8 lines 53-55).

Harui does not teach wherein the association is at least two files connected by at least one pointer.

Ross teaches a method and system for performing joins and self-joins in a database system (see abstract), in which he teaches wherein the association is at least two files connected by at least one pointer (column 25, claim 24).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Harui by the teaching of Ross because wherein the association is at least two files connected by at least one pointer would enable the maximization of the usage of available main memory (Ross, column 3 lines 65-66).

Response to Arguments

8. Applicant's arguments with respect to claims 10-19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia M. Lewis whose telephone number is 571-272-5599. The examiner can normally be reached on Monday - Friday, 9 - 6:30, alternate Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on 571-272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alicia Lewis
March 16, 2007



SAM RIMELL
PRIMARY EXAMINER